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EXAMINER				
RINES, ROBERT D				
ART UNIT		PAPER NUMBER		
3686				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

09/925,571

**Applicant(s)**

HAAKSMA ET AL.

**Examiner**

R. David RINES

**Art Unit**

3686

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

[1] This communication is in response to the amendment filed 6 February 2009. Claims 1-44 are pending.

Rejections of claims 1-44 are maintained as set forth in the previous Office Action mailed 6 October 2008, herein incorporated by reference. Applicant has not amended any of the claims. Applicant declaration is addressed below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[2] Claims 1-3, 5-8, 11-16, 18-24, 27, 29-35, 36-39, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Segal et al., (United States Patent Application Publication #2001/0041991).

[A] As per claim 1, Segal et al., disclose a method of creating a conveniently accessible medical history for a patient, said method comprising the steps of: 1) establishing an information-transmission connection with a remote information-input node (Segal et al.; paragraph [0104]); 2) receiving medical information through said information-transmission connection from said information-input node (Segal et al.; paragraphs [0104] [0110]); 3) configuring said information into a medical history record (Segal et al.; paragraphs [0110] [0111]), which medical history record is storable on a portable readable storage medium (Segal et al.; paragraphs [0144] [0145][0146] [0151]); and 4) transmitting said medical history record to a remote record output node which record output node is configured to store said medical history record on said portable readable storage medium (Segal et al.; paragraphs [0144] [0145][0146] [0151]); whereby a conveniently accessible medical history can be created by storing said medical history record on said portable readable storage medium (Segal et al.; paragraphs [0110] [0111] [0151]).

[B] As per claim 2, Segal et al., disclose further comprising the step of decrypting medical information received through said information-transmission connection (Segal et al.; paragraphs [0085] [0137]).

[C] As per claim 3, Segal et al., disclose further comprising the step of encrypting said medical history record prior to transmitting said medical history record to said record output node (Segal et al.; paragraphs [0085] [0137]).

[D] As per claim 5, Segal et al., disclose wherein said transmitting step comprises transmitting said medical history record to a remote record output node, which record output node is configured to store the medical history record on the portable readable storage medium and to allow a medical practitioner to inspect the medical history record prior to storage of the medical history record (Segal et al.; paragraphs [0110] [0111] [0024]).

[E] As per claim 6, Segal et al., disclose the establishing step comprising establishing an information-transmission connection with a remote information-input node, which information-input node includes a computer (Segal et al.; paragraphs [0110] [0111]).

[F] As per claim 7, Segal et al., disclose the establishing step comprising establishing an information-transmission connection with a remote information-input node, which information-input node includes a fax machine (Segal et al.; paragraphs [0023] [0118]), said information-transmission connection including a connection with said fax machine (Segal et al.; paragraphs [0118]).

[G] As per claim 8, Segal et al., disclose the configuring step further comprising configuring the information into a medical history record which is readable and displayable by an internet browser (Segal et al.; paragraph [0100]).

[H] As per claim 11, Segal et al., disclose the establishing step comprising establishing an information-transmission connection with an information-input node, which information-input node includes a storage computer storing medical information (Segal et al.; paragraph [0015]).

[I] As per claim 12, Segal et al., disclose the establishing step comprising establishing an information-transmission connection with a remote information-input node, which information-input node includes a scanner for scanning images and translating the images to a computer-storable format (Segal et al.; Abstract and paragraphs [0022] [0023] [0027]).

[J] As per claim 13, Segal et al., disclose wherein said configuring step further includes including in said medical history record medical condition information relating to a medical condition of said patient (Segal et al.; paragraphs [0024] [0113]).

[K] As per claim 14, Segal et al., disclose wherein said configuring step further includes including in the medical history record medical condition information relating to a medical condition of the patient, the medical condition information including information on symptoms and treatment of the medical condition (Segal et al.; paragraph [0113]).

[L] As per claim 15, Segal et al., disclose a method of creating a conveniently accessible medical history for a patient, said method comprising the steps of: 1) establishing an information-transmission connection with a remote record-creating node (Segal et al.; paragraph [0104]); 2) transmitting medical information through said information-transmission connection to said record-creating node (Segal et al.; paragraphs [0104] [0110]), said record-creating node being adapted to configure said information into a medical history record (Segal et al.; paragraphs [0110] [0111]), said medical history record being storable on a portable readable storage medium (Segal et al.; paragraphs [0144] [0145][0146] [0151]); 3) receiving said medical history record from said record-creating node (Segal et al.; paragraphs [0144] [0145][0146] [0151] ); and 4) storing said medical history record on said portable readable storage medium (Segal et al.; paragraphs [0110] [0111] [0151]).

[M] As per claim 16, Segal et al., disclose further comprising the step of encrypting said medical information prior to transmitting said information to said record-creating node (Segal et al.; paragraphs [0085] [0137]).

[N] As per claim 18, Segal et al., disclose said method further comprising the step of decrypting said medical history record received from said record creating node (Segal et al.; paragraphs [0085] [0137]).

[O] As per claim 19, Segal et al., disclose further comprising the step of inspecting said medical history record prior to the storing step (Segal et al.; paragraphs [0024] [0110] [0111]).

[P] As per claim 20, Segal et al., disclose the storing step comprising storing the medical history record on a compact disk (Segal et al.; paragraph [0151]).

[Q] As per claim 21 Segal et al., teach the storing step comprising storing the medical history record on a compact disk which is approximately the size of a conventional credit card (Segal et al.; paragraphs [0030] [0143]-[0145] [0148] [0151]).

[R] As per claim 22, Segal et al., disclose the establishing step comprising establishing an information-transmission connection which includes an internet connection (Segal et al.; Abstract and paragraph [0021]).

[S] As per claim 23, Segal et al., disclose wherein the step of transmitting said information comprises transmitting said information by fax (Segal et al.; paragraph [0118]).

[T] As per claim 24, Segal et al., disclose further comprising, prior to said transmitting step, the step of scanning medical information images with a scanner for translating images into a computer storable form (Segal et al.; Abstract and paragraphs [0022] [0023] [0027]).



[U] As per claim 27, Segal et al., disclose the receiving step comprising receiving a medical history record, readable and displayable by an internet browser, from the record-creating node (Segal et al.; paragraph [0100]).

[V] As per claim 29, Segal et al., disclose the transmitting step comprising transmitting medical information through the information-transmission connection to the record-creating node, which record-creating node is associated with an application service provider (Segal et al.; Fig. 1 and paragraphs [0110] [0111]).

[W] As per claim 30, Segal et al., disclose system for creating a conveniently accessible medical history for a patient, said system comprising: an information-input node for receiving medical information and transmitting said information through an information-transmission connection (Segal et al.; paragraphs [0104] [0110]); a record-creating node, remote from said information-input node (Segal et al.; paragraphs [0110] [0111]), for receiving said information through said information-transmission connection (Segal et al.; paragraphs [0110] [0111] [0113]), for configuring said information into a medical history record (Segal et al.; paragraphs [0110] [0111] [0113]), and for transmitting said medical history record (Segal et al.; paragraphs [0110] [0137]); a record output node, remote from said record-creating node (Segal et al.; paragraphs [0137] [0144][0145] [0146]), for receiving said medical history record from said record-creating node (Segal et al.; paragraphs [0137] [0144][0145] [0146]) and for storing said medical history record on a portable readable storage medium (Segal et al.; paragraph [0151]).

[X] As per claim 31, Segal et al., disclose said information-input node including means for encrypting said information transmitted through said information-transmission connection (Segal et al.; paragraphs [0085] [0137]).

[Y] As per claim 32, Segal et al., disclose said record creating node including means for encrypting said medical history record transmitted from said record-creating node to said record output node (Segal et al.; paragraphs [0085] [0137]).

[Z] As per claim 33, Segal et al., disclose said record output node including means for decrypting said medical history record (Segal et al.; paragraphs [0085] [0137]).

[AA] As per claim 34, Segal et al., disclose said record output node being configured to permit inspection of said medical history record by a medical practitioner prior to said medical history record being stored on said portable readable storage medium (Segal et al.; paragraphs [0024] [0110] [0111]).

[BB] As per claim 35, Segal et al., disclose wherein said portable readable storage medium is a compact disk (Segal et al.; paragraph [0151]).

[CC] As per claim 36, Segal et al., teach wherein said portable readable storage medium is approximately the size of a conventional credit card (Segal et al.; paragraphs [0030] [0143]-[0145] [0148] [0151]).

[DD] As per claim 37, Segal et al., disclose said information-input node comprising a computer (Segal et al.; paragraphs [0110] [0111]).

[EE] As per claim 38, Segal et al., disclose said information input node further comprising a fax machine (Segal et al.; paragraphs [0023] [0118]), said information-transmission connection further comprising a connection between said fax machine and said record-creating node (Segal et al.; paragraphs [0118]).

[FF] As per claim 39, Segal et al., disclose said medical history record being configured so as to be readable and displayable by a conventional internet browser (Segal et al.; paragraphs [0100]).

[GG] As per claim 42, Segal et al., disclose said record creating node being associated with an application service provider (Segal et al.; Fig. 1 and paragraphs [0110] [0111]).

[HH] As per claim 43, Segal et al., disclose a system wherein said portable readable storage medium is approximately the size of a conventional credit card (Segal et al.; paragraphs [0030] [0143]-[0145] [0148] [0151]).

[II] As per claim 44, Segal et al. disclose said record creating node including means for encrypting said medical history record transmitted from said record-creating node to said record output node (Segal et al.; paragraphs [0085] [0137]).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

[4] Claims 4, 9, 10, 17, 25-26, 28, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal et al., in view of Felsher (United States Patent Application Publication #2002/0010679).

[A] As per claims 4 and 17, although Segal et al., teach the use of encryption in transmitting data (Segal et al.; paragraphs [0085] [0137]), Segal et al., fails to specifically teach the use of PKI encryption.

[i] However, Felsher teach wherein said encrypting step comprises encrypting by PKI encryption (Felsher; paragraph [0270]).

[ii] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Segal et al., with those of Felsher. Such combination would have resulted in a mobile electronic medical records system capable of delivering records encrypted with a public key-private key (PKI) recognition (Felsher; paragraph [0269]). The motivation to combine would have been ensure that when a recipient seeks a record, he must identify himself, his role in the patient care, and the identity of the patient and/or record (Felsher; paragraph [0254]).

[B] As per claims 9-10, 25-26, 40-41, although the system and method disclosed by Segal et al., is Internet based, Segal et al., does not specifically teach the use of HTML (claims 9, 25, and 40) or XML (claims 10, 26, and 41).

[i] However, Felsher teach the configuring step further comprising configuring the information into a medical history record which is represented in HTML (claims 9, 25, and 40) (Felsher; paragraph [0107]). Felsher further teach the configuring step further comprising configuring the information into a medical history record which is represented in XML (claims 10, 26, and 41) (Felsher; paragraph [0303]).

[ii] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Segal et al., with those of Felsher. The motivation to combine would have been to use a common file-tagging format, for example extensible markup language (XML) to encode records such that elements would be tagged in a standardized format (Felsher; paragraph [0303]).

[C] As per claim 28, Segal et al., does not specifically disclose the use of a format compatible with the record-creating node.

[i] However, Felsher does teach said method further comprising, prior to said transmitting step, the step of translating the medical history information into a format compatible with the record-creating node (Felsher; paragraphs [0302] [0303]).

[ii] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Segal et al., with those of Felsher. The motivation to combine would have been to utilize a common file-tagging format to enhance the level of interoperability and portability of electronic medical records between various health care professionals and researchers (Felsher et al.; paragraphs [0302] [0303]).



***Response to Remarks/Declaration***

[4] Applicant's remarks/declaration filed 6 February 2009 have been fully considered but they are not persuasive. The remarks/declaration are addressed below.

The Declaration filed on 6 February 2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Segal et al. reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Segal et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Applicant's declaration as presented in the response filed 6 February 2006 provides indication of a registered web address (Network Solutions Document) and a timeline indicating the launch of a product (Business Plan Document). While these documents serve to indicate intent to establish and market an Internet-based product/service, the evidence presented fails to delineate any of the functionality claimed in the present application. Accordingly, the declaration as filed fails to overcome the Segal et al. reference.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. David RINES whose telephone number is (571) 272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GERALD J. O'CONNOR can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/R. D. R./  
Examiner, Art Unit 3686  
April 13, 2009

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
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